UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,292	03/27/2001	Daniel F. Williams	PSTM0042/MRK	1726

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EXAMINER
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ART UNIT	PAPER NUMBER
3629	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
	09/820,292	WILLIAMS ET AL.
Office Action Summary	Examiner	Art Unit	
	JAMISUE A. PLUCINSKI	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 October 2008*.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21,27,60-65,100-103 and 138-141* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-21,27,60-65,100-103 and 138-141* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
       1.☐ Certified copies of the priority documents have been received.
       2.☐ Certified copies of the priority documents have been received in Application No. _____.
       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1.   35 U.S.C. 101 reads as follows:

> a.   Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2.   Claims 1-21, 27, 60-65, 100-103, and 138-141 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

3.   The first step in determining whether a claim recites patent eligible subject matter is to determine whether the claim falls within one of the four statutory categories of invention recited in 35 USC 101: process, machine, manufacture and composition of matter. The latter three categories define "things" or "products", while a "process" consists of a series of steps or acts to be performed.

4.   In Claims 1-21, 27 and 138-141 the claims are directed towards a system with is programmed to perform method steps, without any structural claim limitations. The claims recite steps which are performed by the system, however the claims do not recite any structure which performs the method steps such as a processor, computers or servers. Therefore causing the claims to not be tangible and it being unclear whether it is a system claim or a method.

5.   In Claims 60-65, the claims are drawn to a method. For purposes of 101, a "process" has been given a specialized, limited meaning by the courts. Based on In re Bilski (Federal Circuit 2007-1130), the court outlined a test used to determine whether a method satisfies 35 USC 101, is a machine-or-transformation test. In re Bilski states "the machine-or-transformtion test is a two-branched inquiry; an applicant may show that a

process claim satisfies 101 either by showing that his claim is tied to a particular

machine, or by showing that his claim transforms an article. See Benson, 409 U.S. at 70.

Certain considerations are applicable to analysis under either branch. First as illustrated

by Benson and discussed below, the use of a specific machine or transformation of an

article must impose meaningful limits on the claim's scope to impart patent-eligibility.

See Benson, 409 U.S. at 71-72. Second, the involvement of the machine or

transformation in the claimed process must not merely be insignifigant extra-solution

activity. See Flook, 437 US at 590. Claims 60-65 are drawn to a method using a

computer for return processing, however the computer is not used in the body of the

claim in any way, therefore can serve as a display which instructs a user to perform

certain steps. The computer in the preamble is not positively recited and therefore lends

itself to being insignificant extra-solution activity de to the fact that a particular machine

is not recited in the claims as doing any of the steps, and therefore the claims do not pass

the machine-or-transformation test and are hence not directed to statutory subject matter.

6.   With respect to Claims 100-103: the preamble of the claim recites the use of a

"computer product... the computer product having instructions for..." The applicant has

only claimed the computer product without embodying the product on a proper medium,

therefore the claims are directed solely to software, which is considered non-statutory

material. In order for the claim to become statutory the computer product must be

embodied on a physical medium as well as be executable by a computer and cause the

computer to perform the outlined functions.

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> b.   A patent may not be obtained though the invention is not identically disclosed or described as
> set forth in section 102 of this title, if the differences between the subject matter sought to be patented
> and the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

8.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the

various claims was commonly owned at the time any inventions covered therein were

made absent any evidence to the contrary. Applicant is advised of the obligation under

37 CFR 1.56 to point out the inventor and invention dates of each claim that was not

commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

9.   Claims 1-10, 19-21, 60-65, and 100-102 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Schwab et al. (US 2002/0019777) in view of Siegel (US

2004/01435519), Junger (6,269,344) and Kara (6,233,568).

10.   With respect to Claims 1-9, 60-65, and 100-102: Schwab discloses the use of an

online merchandise return computer system (see abstract, the examiner considers the

online merchandise return computer system to include both the merchant computer, as

well as the third party/agent computer, due to the fact that they both computers

cooperatively work together, to process and return a product) where the computer system

is programmed to:

11.   Receive an indication of shipment of an item and an indication that the item is

potentially returnable (see ReturnCert, and Paragraph 0052-0053, the examiner considers

the items to be potentially returnable, due to the fact that they have yet to be returned,

therefore they are potentially returnable).

12.   Save a set of return rules which is inputted by a merchant (Paragraphs 0052 and

0053) where the rules provides exceptions where a user cannot return item (Paragraph

0071)

13.   Receive an online return request by a consumer (Paragraph 0052);

14.   Determine a set of information about the particular respective item of

merchandise (the examiner considers the information gathered from the return questions

to be determining a set of information about the item, Parameter request, reference

numeral 605, product return parameters, such as description of product and condition of

product)

15.   Compare the set of information with the set of return rules (Paragraph 0012 and

0053).

16.   Schwab discloses the use of a set or return questions (Parameter request, reference

numeral 605, product return parameters, such as description of product and condition of

product), and processing the return according to the rules (See Paragraphs 0012, and

Paragraph 0053).

17.   Schwab discloses if the item is returnable to provide the user with the Return cert,

in which the user can use to deliver the item to the merchant (See Figure 9 with

corresponding detailed description, and Paragraphs 0014-0015).

18.   Issue a credit to the user for the return (see abstract and Paragraphs 0003-006),

19.   Schwab, however, fails to disclose the use of a display, which displays each item of a previous order and an interactive means associated with each item in each order, to return an item. Siegel discloses a return system where a user's previous orders along with each item in the order are displayed, and each item is associated with a checkbox, which the examiner considers to be an interactive means, to submit a return request (See Figure 1A with corresponding detailed description). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Schwab to include the display and interactive means of Siegel, in order to provide a single action return process to reduce the amount of sensitive information transmitted to increase security and ease of use for the customer (See Siegel, Pages 1 and 2).

20.   Schwab and Siegal disclose the use of a method for authorizing returns, however Schwab and Siegal disclose the initiation of the return being through a third party website, and fails to disclose it being through the online retail computer system. Junger discloses the use of a return system at a local site, then this information is sent to a remote approval computer system for authorization of the return (Column 2, lines 46-67). Therefore, with the return processing method of Schwab and Siegal, disclosing the claim limitations of Claim 1. Because both Schwab and Siegal and Junger teach methods for returning purchased items, it would have been obvious to one skilled in the art to substitute one method for the other to achieve the predictable result of returning an item to a retailer. (See KSR International Coo. V. Teleflex Inc., 550 US-82 USPQ2d 1385 (2007))

21.   Schwab, Siegal and Junger, disclose the use of shipping the return to the manufacturer, but fail to discloses displaying multiple carriers for use by the user to ship

the item to the merchant. Kara discloses the use of a system used to select a carrier for shipment and calculating shipping rates for a plurality of carriers (See Figure 8, with corresponding detailed description). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Schwab, to include the ability to select a carrier and calculate the shipping rates for the carriers, according to Kara, in order to for the user to make an informed choice as to the most preferable method of shipment. (See Kara, abstract). Furthermore all of the method steps are known in Schwab, Siegal, Junger and Kara. The only difference is the combination of "old steps" into one method of returning and allowing the user to choose the carrier. Thus, it would have been obvious to one having ordinary skill in the art to display the carriers to the user as taught by Kara, in the return method of Schwab, Siegal and Junger, since the method of displaying multiple carriers which can be used to ship the return, is used to achieve predictable results of giving the user a choice. (See KSR [127 S Ct. at 1739] "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.").

22.   With respect to the limitation of the set of carriers "that was pre-selected by the particular online merchant from a list of available carriers": this is not a positively recited step of the system, and is done outside of the system as claimed, therefore does not functionally affect the system, due to the fact that the selection was done before the carriers were displayed. The prior art discloses multiple carriers being displayed to ship a package, who chose the carriers is done outside of the method the computer is performing, therefore is not functionally related to the steps in the claims.

23.   With respect to Claims 10-12, 27, 62-65, 103, and 138-141: See Kara, Figure 8

with corresponding detailed description.

24.   With respect to Claims 19 and 20: Siegel discloses the use of an online

merchandise return system, which prints shipping labels for returns (See abstract).

25.   With respect to Claim 21: See Siegel, Figure 1A, and Figure 5 with corresponding

detailed descriptions

26.   Claims 13-21, 27, and 65 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Schwab, Siegel, Junger and Kara as applied to claim 11 above, and

further in view of UPS® Service Guide (www.ups.com) and FedEx® Services

(www.fedex.com) and Barnett et al. (6,369,840).

27.   With respect to Claims 13-16, 27, and 65: Schwab and Kara discloses an onscreen

interactive display with a selection and comparison section for a plurality of carriers with

a plurality of services (See Kara, Figure 8). However Kara does not specifically disclose

the rates being calculated with respect to time. Both UPS® and FedEx® disclose specific

services where they are guaranteed delivery by a certain time in the day. It would have

been obvious to one having ordinary skill in the art at the time the invention was made to

include the time sensitive "urgency" services, as disclosed by FedEx® and UPS®, in

order to ship thing and compete with a time advantage using guaranteed delivery times

and to reduce costs, when delivery time is not of importance. (See Fed Ex Page 1). Kara,

UPS® and FedEx® fail to disclose the use of a graph which simultaneously displays a

graph of shipping fees and services, where one axis being date and one axis being time

and where each cell is located at the intersection of the date and time. Barnet discloses

the use of a calendar which can be sued for online purchasing of services (column 2, lines 63-67), where there is a graphical representation of date on one axis and time on another (See Figure 9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to display the calculation of shipping rates, calculated by Kara, UPS® and FedEx®, in the format of a plurality of cells with date on one axis and time on another, as disclosed by Barnett, in order to provide a multi-layers system wherein different categories can be overlaid on one another providing a single integrated display that allows a user to order or purchase a system based on the calendar day and time (See Barnett, column 2).

28.   With respect to Claim 17: See Schwab, return transaction 619.

29.   With respect to Claim 18: See Kara, Figure 9.

Response to Amendment

30.   The affidavit under 37 CFR 1.132 filed 10/8/08 is insufficient to overcome the rejection of claims 1-21, 27, 60-65, 100-033, and 138-141 based upon Schwab, Siegel, Junger and Kara as set forth in the last Office action because: First the affidavit is filed by the inventor, which has a vested interest in the outcome of the application and is therefore not considered to be an unbiased opinion. The affidavit filed, is an opinion-based affidavit, based on the opinion of the person making the affidavit, not based on any facts which are presented. Due to the fact that the opinion of the inventor can be swayed due to the fact that there is a vested interest in the application becoming a patent, the opinion is not considered to be objective and unbiased, therefore not persuasive.

Second, the affidavit is not considered to be commensurate with the scope of the claims.

The affidavit is stating that Sigel does not teach showing only the times which have

shipped. However, the claims only recite items which are "potentially returnable". And

item which has been purchased, yet not shipped is still "potentially returnable".

Therefore the person making the affidavit is arguing limitations which are not present in

the applicant.

31.   With respect to Applicant's argument that Kara does not disclose displaying a list

of carriers which have been pre-selected by the merchant from a list of carriers: this is a

newly added claim limitation which the examiner has addressed above in the rejection.

The pre-selecting is done outside of the method that the system is performing, therefore

the display of carriers would be the same regardless of whether it was pre-selected by a

merchant or pre-selected by a computer system, therefore not functionally related to the

method or system which is performing the method.

32.   With respect to Applicant's argument that the prior art references teach the item

must be returned to the store in person before shipping the return: Schwab discloses

requesting the return of an item to an online retail system, everything is done online with

Schwab. Schwab however discloses the use of a third party which does the processing,

now the same online merchant system which the item was purchased through. Junger is

used only to show that instead of using a third party, that a person can initiate a return

directly though the retailer/merchant, as opposed to go through a third party. The online

merchant request is being taught by Schwab, not by Junger.

33.   With respect to applicant's argument that none of the references show a display of

"shipped" items: As stated in the response to the affidavit, the claims recite items which

are "potentially returnable" not ones which have been shipped. An item which has been

purchased, yet not shipped, is still considered to be potentially returnable. The applicant

states that the limitation of the potentially returnable items being shipped items, however,

the examiner cannot find where this is positively recited in the claims. Therefore any

items which have been purchased is considered to be potentially returnable.

34.   With respect to Applicant's argument that none of the references disclose a user

interface which is adapted for receiving input identifying at least one items as an

exception to standard return policy rules: It has been held that the recitation that an

element is "adapted to" perform a function is not a positive limitation by only requires

the ability to so perform. It does not constitute a limitation in any patentable sense. *In re*

Hutchinson, 69 USPQ 138. Therefore the user interface has a user input section,

therefore fully capable of allowing a user it identify an exception to a standard return

policy rule.

35.   With respect to Applicant's argument that Schwab does not disclose the use of

return questions: As stated above Schwab discloses a parameter request, reference

numeral 605, product return parameters, such as description of product and condition of

product. Given the broadest reasonable interpretation the examiner considers these to be

equivalent to questions. The claims do not recite specifically what questions, therefore

given the broadest reasonable interpretation, the return parameters of Schwab are

considered to be return questions.

36.   With respect to Applicant's argument that none of the references disclose

generating a display of an interactive graphic comparison of calculated shipping rates at

the intersection of corresponding delivery dates and times: Not one reference alone

teaches this feature, however the combinations of Kara, UPS, FedEx, and Barnett

disclose this feature, as stated above. Kara teaches the display of multiple services of

multiple carriers, UPS and FedEx disclose the use of time and date being calculated with

shipping, and Barnett discloses the calendaring system, therefor the combination of ALL

these references teaches these features together. The applicant argues that there is no

motivation to combine Barnett with the other references due to the fact that Barnett does

not disclose as being used for shipping or returns. Barnett however does disclose the

calendaring system to be used with scheduling services. Shipping and returns are

considered to be services and can be scheduled according the UPS and FedEx references;

therefore it is the examiner's position that there is motivation to combine.

37.   Applicant's arguments are not considered to be persuasive and the rejections stand

as stated above.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to JAMISUE A. PLUCINSKI whose telephone number is

(571)272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR. Status

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more information about the PAIR system, see http://pair-direct.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business

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Customer Service Representative or access to the automated information system, call

800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamisue A. Plucinski/
Primary Examiner, Art Unit 3629